



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/529,587 | 04/14/2000 | JOHN A. DANE | EPRNT-101XX | 2045 |

7590 04/09/2003

Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

| | |
|-----------------|--------------|
| EXAMINER | |
| TODD, GREGORY G | |
| ART UNIT | PAPER NUMBER |
| 2157 | |

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529,587

Applicant(s)

DANE ET AL.

Examiner

Gregory G Todd

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This is a first office action in response to application filed, with the above serial number, on 14 April 2000 in which claims 1-31 are presented for examination. Claims 1-31 are therefore pending in the application.

Information Disclosure Statement

1. The information disclosure statement filed 14 April 2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
The signatures are not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a).

Specification

Art Unit: 2157

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The terminology of a "payment verifier" and an "image loader" is not in the specification.

Claim Objections

4. Claim 6, and similarly claim 12, are objected to because of the following informalities: In line 8, "publically" is suggested to be replaced with --publicly--. Appropriate correction is required.

5. Claim 1 is objected to because of the following informalities: In line 15, "institution," is suggested to be replaced with --institution; and--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2,3,4 recite the limitation "said ordering interface access providing step" in line 1. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 9-10, 13, 16-17, 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Maniwa (hereinafter "Maniwa", 5,764,866).

11. As per Claim 9, Maniwa discloses a method of remotely uploading, storing, reviewing, and editing electronic photographic images, wherein Maniwa discloses:

fixing visual images on a persistent medium (image to be scanned) (at least col. 5, lines 48-53);

translating said visual images into electronic photographic images (scanning) (at least col. 5, lines 48-56);

transmitting said electronic photographic images to an order server (file/scan server) (at least col. 20, lines 16-22; col. 19, lines 48-50);

storing said electronic photographic images on a memory at said order server (at least col. 19, lines 48-50);

displaying selected electronic photographic images from said memory to a remote customer (list user obtains) (at least col. 21, lines 52-62);

receiving an order from said remote customer enumerating a subset of said electronic photographic images (sending file request command for printout) (at least col. 20, lines 5-15);

producing a hardcopy rendition of said subset of electronic photographic images (printing) (at least col. 20, lines 51-54).

12. As per Claim 10.

wherein said translating comprises scanning a visual image into a digital storage format (at least col. 18 line 66 - col. 19 line 4).

13. As per Claim 13.

wherein the step of storing is followed by the step of sequencing and captioning said electronic photographic images (image file - 1...m) (at least Fig. 6).

14. As per Claim 16.

wherein said displaying is followed by the step of electing a quantitative and qualitative assertion for at least one of said electronic photographic images (user selecting one or more displayed images) (at least col. 21, lines 52-62).

15. As per Claim 17.

wherein said electing further comprises storing at least one of said electronic photographic images in an electronic proofbook (directory service for user image list) (at least col. 21, lines 52-62).

16. As per Claim 19, has substantially similar content to claim 16 and is rejected as per claim 16.

17. As per Claim 20.

Art Unit: 2157

wherein said storing is preceded by the step of remotely altering/editing said electronic photographic images (image resolution conversion, rotation, etc) (at least col. 18, lines 17-58).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-8, 12, 14, and 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa (hereinafter "Maniwa", 5,764,866) in view of Wilf et al (hereinafter "Wilf", 5,899,980)

20. As per Claims 1 and 21, Maniwa discloses a computer method for storing and saving electronic photographic images, wherein Maniwa discloses:

providing access to an order server (scan server) having picture image memory adapted to store said electronic photographic images, an ordering interface, and a communications link (digital copier device over LAN) (at least col. 5, lines 48-67; Fig. 7);

providing access to an image loader operable to receive said electronic photographic images and store said images in said picture image memory (scanning/storing at file-server) (at least col. 5, lines 48-56; col. 19, lines 28-43);

providing access to a photographic printer adapted to produce hardcopy renditions of said electronic photographic images (printer) (at least col. 6, lines 43-49);

Art Unit: 2157

wherein said ordering interface is operable to be remotely accessed by a user for the purpose of selectively directing said photographic printer to produce said hardcopy renditions (controlling of printer unit) (at least col. 6 line 61 - col. 7 line 5; col. 8, lines 6-16; Fig.).

Maniwa does not disclose providing access to a payment verifier adapted to transact remote payment information through a financial institution. However, the use and advantages for using such a payment method is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Wilf. Wilf discloses verifying and validation payment of goods purchased at a point-of-sale computer workstation (at least col. 11 line 57 - col. 12 line 5; abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Wilf's payment and verification method into Maniwa's system because this would allow Maniwa's system to be used over a WAN such as the internet and the file and print server to be used in conjunction with selling consumer electronic photos as this would expand and enhance Maniwa's system to reach more consumers and provide a faster, easier payment method.

21. As per Claims 2 and 22.

wherein said ordering interface access providing step further comprises providing access to an image profiler adapted to sequence and label said electronic photographic images (image file - 1...m) (at least Fig. 6).

22. As per Claims 3 and 23.

Art Unit: 2157

wherein said ordering interface access providing step further comprises providing access to a customer order selector adapted to enumerate and quantify a subset of said electronic photographic images to be produced as said hardcopy renditions (sending file request command for printout) (at least col. 20, lines 5-15).

23. As per Claims 4 and 24.

wherein said ordering interface access providing step further comprises providing access to a customer proofbook adapted to store a subset of said electronic photographic images, wherein said customer proofbook persists between said remote accesses by said customer (directory service for user image list) (at least col. 21, lines 52-62).

24. As per Claims 5 and 25.

Maniwa does not disclose wherein said payment verifier access providing step enables transmitting payment corresponding to production of said hardcopy renditions in response to notification from said financial institution. However, the use and advantages for using such a payment confirmation is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Wilf. Wilf discloses the server verification confirmation indicating to supply goods upon payment (at least Fig. 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Wilf's payment and verification method into Maniwa's system because this would allow Maniwa's system to only continue with the printing process if the user is authorized to print, as this would further reduce unwanted workload on Maniwa's host machine (Maniwa col. 4, lines 25-30).

Art Unit: 2157

25. As per Claims 6 and 26.

wherein said image loader access providing step enables receiving said electronic photographic images from a transmission over a publicly accessible network through said communications link (at least col. 21, lines 44-51; col. 22, lines 15-21).

26. As per Claims 7 and 27.

wherein said image loader access providing step enables receiving said electronic photographic images from a non-volatile digital media (hard drive) (at least col. 7, lines 29-30).

27. As per Claims 8 and 28.

wherein said non-volatile digital media is selected from the group consisting of magnetic and optical formats (hard drive) (at least col. 7, lines 29-30).

28. As per Claim 12.

Maniwa discloses a multi-network environment but does not explicitly disclose transmission over a publicly accessible network. However, the use and advantages for using such a network is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Wilf. Wilf discloses using the internet for authorizing transactions (at least Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the use of a public network such as the internet with Maniwa's multi-network system as this would enhance the reach of Maniwa's system with more vendors.

29. As per Claim 14.

Art Unit: 2157

wherein said displaying is in response to interactive selecting by said customer through said publicly accessible network (user selecting image file) (at least col. 21, lines 52-62).

30. As per Claim 29.

Maniwa discloses the system as substantially shown and described herein (at least Abstract).

31. As per Claim 30.

further including the step of providing access to stored images for allowing image editing (image resolution conversion, rotation, etc) (at least col. 18, lines 17-58).

32. As per Claim 31.

wherein said editing step includes one or more of the steps of categorizing, sorting and titling (image file ID/name) (at least col. 14, lines 25-28).

33. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa in view of Morag et al (hereinafter "Morag", 6,058,399).

Maniwa and Wilf do not disclose using a digital camera to store said visual images therein. However, the use and advantages for using such an electronic photo capturing is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Morag (at least col. 6, lines 44-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate using a digital camera to create electronic photos to print as this was a

Art Unit: 2157

commonly used method and alternative of creating digital photos along with scanning film.

34. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa in view of Westmoreland (hereinafter "DMW", DMW Photo Images).

Maniwa does not explicitly disclose arranging said electronic photographic images according to an event and said displaying said electronic photographic images occurs selectively according to said event. However, the use and advantages for using such a photo arrangement is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of DMW (at least pp. 1, 4). DMW discloses arranging photos according to Rock, alternative, etc. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the use of DMW's genre photo arrangement into Maniwa's storing files in a directory service as this would enhance Maniwa's system by allowing the image files to be stored in the directory by an easy to remember method such as a meeting or date, etc.

35. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa.

Maniwa discloses a user directory service for storing and organizing image data files but does not explicitly disclose wherein said electronic proofbook is accessible only by said customer. Official notice is taken that it was well known in the art at the time the invention was made to have authenticity measures so that only a specified user can access particular files. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement having users password protect

Art Unit: 2157

files and/or a directory because this would prevent unauthorized users from viewing image data files that are confidential or private.

Conclusion

36. Martin et al (payment server), Moghadam et al (networking photos), Brindle et al (photo description), Yien et al (networked image editing), Loeb (multimedia, photo delivery mechanisms), Woods (Kodak abstract for system claimed dated August '97), DaleLabs (digital film developing), Oldroyd Digital (digital film printing and editing), and WebPhotos (a very identical system to that claimed) are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G Todd whose telephone number is (703)305-5343. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



Application/Control Number: 09/529,587

Page 13

Art Unit: 2157

gt

April 7, 2003

A handwritten signature in black ink, appearing to read 'Saleh Najjar', written in a cursive style.

**SALEH NAJJAR
PRIMARY EXAMINER**